The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN A. GIULIANI,
SCOTT R. VANDEVELDE,
and WALEED AL-ATRAQCHI

MAILED

MAY 13 2005

U.S PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2002-2256
Application 09/286,304[1]

ON BRIEF

Before JERRY SMITH, BARRETT, and SAADAT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON SECOND REQUEST FOR REHEARING

Appellants filed a "37 CFR 41.52(b) SECOND REQUEST FOR REHEARING" (Paper No. 24) (pages referred to as "2dRR__") from our decision on request for rehearing (Paper No. 23).

[1] Application for patent filed April 6, 1999, entitled "Method and Apparatus for Generating Purchase Incentives Based on Price."

The second request for rehearing has been considered but is denied with respect to making any changes in our decision on request for rehearing.

OPINION

In appellants' original 37 CFR 1.197(b) REQUEST FOR REHEARING (Paper No. 22), appellant argued that our original decision (Paper No. 21) imposed new grounds of rejection. On rehearing, we decided that appellant was perhaps correct. After reviewing the whole record in light of appellants' arguments, we decided that the examiner's decision was, in fact, correct and that our new reasoning in the decision was unnecessary. We vacated that part of our original decision where we sustained the rejection of claims 10-13, 15, 17-20, 22, and 24, and sustained the examiner's rejection of these claims; thus, the decision of the examiner as to these claims was affirmed. Because our decision on rehearing was, in effect, a first decision, we authorized appellants to file a second request for rehearing.

Appellants continue to belabor the use of the term "sustain" (2dRR2). We reiterate the distinction between "sustain" and "affirm" in the decision on rehearing and note that the decision ended with "AFFIRMED." Appellants misrepresent the facts of "In re Scroggie, CAFC docket No. 05-1104 [sic, 2005-1164]" (2dRR2) which did not involve this same panel, as appellants' use of the word "you" would suggest, and which did not involve the

issue about the word "sustain," but was remanded because counsel took a premature appeal to the Federal Circuit. Nevertheless, we will use the term "affirm" to avoid further controversy.

Appellants argue that this panel takes inconsistent positions and "your admission that the examiner failed to make a prima facie case in your original decision and your repudiation on rehearing of your novel reasoning in your original decision leaves you no choice but to reverse the examiner on those original grounds for rejection" (2dRR2-3). It is argued that the examiner admitted that Deaton does not disclose selecting incentive data based on the price of a second item and that our decision on rehearing now agrees with the examiner's argument that it would have been obvious to one of ordinary skill in the art to also select incentive based on the price of a second item in order to allow customer loyalty on purchasing a specific type of product, which is directly contrary to our position in our original decision and, therefore, we have no choice but to reverse the examiner (2dRR4). The request is filled with other arguments about our decision in the request for rehearing being inconsistent with our original decision.

Since we vacated our original decision as to the rejected claims, that decision does not exist and no inconsistency can exist. Appellants quote the language about vacating the decision in bold, but fail to acknowledge its legal significance.

Moreover, appellants' implication that the Board cannot change its mind is without merit: under appellants' reasoning, if we had changed our mind in the decision on rehearing in appellants' favor, we would be inconsistent with what we decided in the original decision and that would not be allowable.

We also disagree with appellants' attempt to characterize the grounds for our affirmance of the rejection. The sole reasons for affirming the rejection are stated on pages 3 and 4 of the decision on request for rehearing. The examiner found that Deaton teaches an incentive system based on a purchase transaction and that a purchase transaction involves purchasing of many items, including a first item having a price, where the rest of the items can be considered second items each having a price. The independent claims (the only claims argued) are so broad that they read on Deaton's disclosure of an incentive system based on the amount purchased when two or more items are purchased. We further commented on the claim breadth. Appellants do not contest the merits of this reasoning, but seek to gain reversal of our decision on technical grounds. To the extent the examiner's answer may be internally inconsistent or provide other reasons that are not relied on or provide reasons that are actually wrong, this is irrelevant. The Board can affirm a rejection based on arguments that are right.

Appellants argue that the examiner did not allege that the existence of a second item provided a "dollar limit," as noted in the quotation on page 3 of our decision on rehearing and that "you should completely discount your surplusage argument, because it clearly is not the ground of rejection imposed by the examiner" (2dRR7).

The quotation on page 3 of our decision on rehearing comments on the claim breadth. We do not consider it a new ground of rejection. Appellants appear to argue that we must affirm the examiner's rejection based solely on what the examiner has said with no additional comments or explanation or claim interpretation allowed. We disagree. The Board often has to clarify the rejections and the facts, interpret the claims, and pick out good arguments from bad arguments and more fully explain those arguments so that they can be reviewed. If every slight discrepancy between what the examiner said and what the Board said constituted a new ground of rejection, there would never be any final decision. Appellants have clearly been given notice of the reasoning for affirming the rejection.

In summary, we have considered appellants' arguments but are not convinced of any error. Accordingly, the second request for rehearing is denied with respect to making any changes in our decision on rehearing, and the decision of the examiner to reject claims 10-13, 15, 17-20, 22, and 24 stands affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

DENIED

JERRY SMITH
Administrative Patent Judge

LEE E. BARRETT
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

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